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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,721	04/10/2001	Glenn R. Smith	IBM 2 0004	8452

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EXAMINER	
VAUGHN, GREGORY J	
ART UNIT	**PAPER NUMBER**
2178	

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/829,721	SMITH ET AL.	
	Examiner	Art Unit	
	Gregory J. Vaughn	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,3,6-8,11-13,15,16,21 and 22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2,3,6-8,11-13,15,16,21 and 22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Action Background

1. This action is responsive to the applicant's response, filed on 1/3/2006.

2. Applicant has not amended any claims with this response.

3. Claims 2, 3, 6-8, 11-13, 15, 16, 21 and 22 are pending in the case, claims 2, 8 and 21 are independent claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."*

5. Claims 2, 3, 6-8, 11-13, 15, 16, 21 and 22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Word 2000, copyright 1983-1999 by Microsoft Corporation (hereinafter MS Word) in view of William B. Hayes *Using PowerBuilder 6*, published by QUE Corporation in 1997 (hereinafter PowerBuilder 6). Note: Screen shots from MS Word have been updated with this action and as

previously mentioned the Hayes reference was accessed on-line and the referenced pages have been provided for the applicant's use. Citations for the Hayes reference listed below use page numbers added to the top of each page by the examiner.

6. **Regarding independent claim 2**, MS Word discloses a text entry dialog box system in a typical computer system. As is well know in the art, a typical computer system would include a display device, a pointing device (usually in the form of a mouse), memory devices, and a processor that executes an application program that would be displayed on the display. MS Word further discloses a text entry space in a dialog box that accepts free form text entry in Figures 5-7.

Figure 5 is the Find and Replace box available from the Edit menu, where the user has not yet entered any search terms. Figure 5 discloses a text entry space in a dialog box displayed on a screen of the display device for free form entry of text by the user. The memory associated with this dialog box is initialized as empty (this memory is initialized as empty each time the MS Word application is started). The empty memory initialization is disclosed in Figure 6 (shown as an empty list).

Figure 7 discloses a user entry of text. The text is stored in memory. The user subsequently entered additional text items (shown in the list of Figure 8). In Figure 8, MS Word discloses displaying a list of previously entered text items that had been stored in memory. To access this list of previously entered text items, the user would select the show-list-button (displayed as a square box with a downward pointing arrow). The show-list-button is well known in the industry.

MS Word fails to disclose the selective display of a selection button (i.e. the show-list-button) associated with the dialog box, where the selection button is visible when at least one text entry is stored in memory. In the examples described above the show-list-button is always displayed. PowerBuilder 6 discloses dialog box controls that have intelligence built into them wherein the controls are conditionally displayed based upon the volume of items in memory. PowerBuilder 6 discloses controls built into the drop down box selection button (the arrow) on page 3. PowerBuilder recites: "*Always Show Arrow: The Always Show Arrow checkbox always shows the arrow that opens the list box. If Always Show Arrow is unchecked, the arrow is shown only when the column has focus.*" PowerBuilder 6 discloses conditional program execution related to visibility of the arrow.

PowerBuilder 6 further discloses the conditional program execution of the visibility of controls in relation to the volume of data in the memory of the list box on page 2. PowerBuilder 6 recites: *"Disable Scroll: If Disabled Scroll is checked, the scroll bar will always be visible but will be disabled when you can access all the items without scrolling. If this property is not checked, the scroll bar will be displayed only if necessary, based on the number of items and the height of the listbox.*" So, if the listbox is set to a height equivalent to less than one line of text, and the memory is empty, then the scroll bar would not be displayed. Furthermore, in this example, if the memory holds one or more text items, the scroll bar would be visible. PowerBuilder 6 discloses selectively displaying a text entry box control, wherein the selective displaying is based upon the items stored in memory.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to modify the MS Word Find and Replace text entry dialog box with the selectively displayed controls as taught by PowerBuilder 6 in order to provide a visible indication that the control is usable.

7. **Regarding dependent claim 3**, MS Word, operating in a standard operating environment, inherently implements a parser, as used by the operating system and the related assembly language, to operate on text entry (as in the dialog box of applicant's invention) to provide for the storage of the text in memory. MS Word also discloses in Figure 8, that text items containing at least one character are stored in memory (shown as the text in the list).

8. **Regarding dependent claim 6**, MS Word discloses the selection button as a drop-down arrow, and the list as a drop-down list, both displayed in association with the dialog box. Figure 5 discloses the arrow to the right of the text entry area. Figure 8 discloses the drop down list shown below the text entry area.

9. **Regarding dependent claim 7**, MS Word discloses a dialog box where the memory associated with the dialog box is initialized as empty each time the associated window is started in Figure 6. The Find and Replace box shown in Figure 6 is initialized as empty each time the MS Word window is launched.

10. **Regarding claims 8, 11-13, 15 and 16**, the claims are directed to a method for the system of claims 2, 3, 6 and 7, and are rejected using the same rationale.

11. **Regarding claims 21 and 22**, the claims are directed to a graphical user interface for the system of claims 2, 3, 6 and 7, and are rejected using the same rationale.

Response to Arguments

12. Applicant's arguments filed 1/3/2006 have been fully considered but they are not persuasive.

13. Regarding the claimed invention, applicant states: "*Conspicuously missing from these PowerBuilder examples is any disclosure or fair suggestion of provision for a drop-down arrow for a combination box that is shown only when there are previous text entries to list*" (page 8, middle of the page, of the response filed 1/3/2006). PowerBuilder 6 discloses selectively displaying a text entry box control, based upon the number of items in memory. If the listbox is set to a height equivalent to less than one line of text, and the memory is empty, then the scroll bar would not be displayed. Furthermore, in this example, if the memory holds one or more text items, the scroll bar would be visible.

14. Regarding applicants request: "*Applicants are unclear as to what is meant by the term "assembly language" and ask for clarification in the forthcoming Office Action*" (page 9, second paragraph, of the response filed 1/3/2006). The examiner has based the rejection on the well-known programming concepts of low level

programming techniques. Parsing is a general term related to breaking data into the smallest chunks possible for use by a computing device (for instance a line of text is broken (i.e. parsed) into the separate words of the line of text). The semantics of the text indicate that the text is either commands or data. High-level programming languages are interpreted by the computing device (i.e. Save File X) and converted to low level computing languages, which are known as assembly languages (i.e. move data in register X to storage device Y). The examiner was indicating that parsing is a fundamentally inherent function of computing devices when converting when processing information from high level programming languages into low-level computer languages.

15. Applicant further states: "the proposed motivation is taken from the present application" (page 11, second paragraph, of the response filed 1/3/2006). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
March 14, 2006

STEPHEN HONG
SUPERVISORY PATENT EXAMINER